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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) CU-4849							
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>7-6-2010</u> Signature <u>Zareefa B. Flener</u> Typed or printed name <u>Zareefa B. Flener</u>		<table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <td style="width: 50%; padding: 5px;">Application Number 10/581,951</td> <td style="width: 50%; padding: 5px;">Filed August 25, 2010</td> </tr> <tr> <td colspan="2" style="padding: 5px;">First Named Inventor Beat Schilling et al.</td> </tr> <tr> <td style="padding: 5px;">Art Unit 2856</td> <td style="padding: 5px;">Examiner Larkin, Daniel Sean</td> </tr> </table>		Application Number 10/581,951	Filed August 25, 2010	First Named Inventor Beat Schilling et al.		Art Unit 2856	Examiner Larkin, Daniel Sean
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Art Unit 2856	Examiner Larkin, Daniel Sean								
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%;"> <tr> <td style="width: 50%; vertical-align: top;"> <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>52,896</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____ </td> <td style="width: 50%; vertical-align: top;"> <div style="text-align: center;">  Signature Zareefa B. Flener Typed or printed name 312-427-1300 Telephone number 7-6-2010 Date </div> </td> </tr> </table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>				<input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>52,896</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	<div style="text-align: center;">  Signature Zareefa B. Flener Typed or printed name 312-427-1300 Telephone number 7-6-2010 Date </div>				
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<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.									

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.8. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Application Serial No. 10/581,951

PATENT Docket: CU-4849

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APPLICANT: Beat Schilling et al.) Group Art Unit: 2855
10/581951 T.W.)
SERIAL NO: 10/581,594) Examiner: Michael T. Cygan
FILED: August 25, 2006)
TITLE: DEVICE FOR SAMPLE PREPARATION)
ATT DKT NO: CU-4849)

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I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted to the United States Patent and Trademark Office to the fax number and on the date indicated above.


Name:**PRE-APPEAL BRIEF ARGUMENTS AND REMARKS**

Sir:

This pre-appeal review is requested for U.S. Serial No. 10/581,951 ("the Present Application") filed August 25, 2006. The outstanding final office action mailed January 6, 2010 rejects claims 1-3 under 35 U.S.C. §103(a) as being obvious and unpatentable over Abdel-Rehim in view of Cronin (U.S. 5,064,418). Claim 3 is also rejected as unpatentable over Abdel-Rehim in view of Cronin and further in view of JP 10-10104 (Takii et al.); and also over Abdel-Rehim in view of Cronin and further in view of Reinhardt et al.

The claims in the present application, U.S. Serial No. 10/581,951, have been twice rejected. Based upon assertions made in the Office Action mailed January 6, 2010, (hereinafter "the Office Action"), Applicant respectfully asserts that the rejections of record are clearly improper and based upon errors in facts.

Applicant respectfully asserts that a case of obviousness under 35 U.S.C. §103(a) has not been established by the Office Action because the proposed modification or combination of wherein a modification of the syringe with the

Application Serial No. 10/581,951

PATENT Docket: CU-4849

arrangement of Cronin would not have been obvious. Accordingly, pre-appeal review is respectfully requested.

In the Office Action, claims 1-3 are rejected under 35 U.S.C. §103(a) as being obvious and unpatentable over Abdel-Rehim in view of Cronin (U.S. 5,064,418). Claim 3 is also rejected as unpatentable over Abdel-Rehim in view of Cronin and further in view of JP 10-10104 (Takii et al.); and also over Abdel-Rehim in view of Cronin and further in view of Reinhardt et al.

The Applicant provides that the remarks in the Office Action have at least not accounted for the following: (1) the two references belong to two entirely different fields of art. Abdel-Rehim discloses a solid phase microextraction (SPME) device whereas Cronin discloses a filtering device. Aside from the fact that both devices have to do with syringes that have nothing in common which would not suggest a combination whatsoever to one skilled in the art; and (2) the suggested combination would still not lead a person of skill in the art to the claimed subject matter because it would not be capable of extracting a volatile component from a gaseous sample.

Abdel-Rehim discloses an SPME device for the preparation of liquid samples. The advantage of this device over the so-called needle trap devices is seen in the fact that with the so-called packed syringe "the problem of the unstableness in the solid phase material of the coated fiber and that the coated fiber is easily damaged are avoided" (p. 2 ll. 29-31). Accordingly, it would definitely not make any sense to reverse the alleged improvement by putting the solid phase back into the needle. It would also make even less sense to refer to Cronin for this reversion of a supposed improvement because Cronin discloses a syringe filter rather than a package of absorbent material.

The system disclosed in Abdel-Rehim is capable of extracting solutes, i.e. molecules of interest, from liquid samples by collecting them on the surface of an absorbent located on the bottom of the glass barrel of a syringe. In this configuration the package of absorbent cannot be heated to assist the desorption. Therefore, the solute has to be desorbed with a comparatively high amount of solvent, i.e. at least 100µl. In practically all gas chromatographic systems only 1-2µl can be injected. This is because a liquid solvent injected in a gas chromatograph has to be evaporated in the injector. Injecting more than 2µl would overload the system. The thought of injecting 100µl of solvent into a gas chromatograph would never occur to one skilled in the art.

Application Serial No. 10/581,951

PATENT Docket: CU-4849

Accordingly, it is clear that Abdel-Rehim is limited to liquid SPME and would not be capable of being used with a gaseous sample.

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On page 3 and again on page 4, the Office Action alleges that one skilled in the art would have been motivated to modify the syringe of Abdel-Rehim with the arrangement of Cronin by the advantage of "allowing for more samples to be collected for greater accuracy". This argument does not make sense because the collection of more samples could definitely never have been a motivation for the suggested modification, because for more sample one would just use a bigger syringe.

The main difference, however, lies in the fact that Abdel-Rehim, with or without the modification with Cronin, would always need a solvent to transfer the solute to an analytical device as opposed to the method and device of the present invention wherein thermal desorption is possible which means that no solvent is needed to transfer the components collected on the active surface of the packing to a gas chromatograph.

Clearly Abdel-Rehim is not the closest art to the present invention. The claimed invention is related to so-called needle trap devices for SPMC such as those disclosed in the prior art mentioned in the introduction of the present application (U.S. 2001/0032521) or in the international search report. These devices allow the collection of solutes from a gaseous phase. In view of its limitation to liquid samples, Abdel-Rehim is far more remote than these references.

However, while the devices disclosed in these references may be capable of sampling gaseous solutes, they are not very efficient because their absorbent surface is small: an SPMC fiber has a surface of ca 10mm² whereas the claimed device can work with a much more effective packing material such as Tenax TA, or which e.g. 44mg have an active surface of 1.5m². Neither Takii et al. nor Reinhardt et al. cure the deficit found in the other references.

The Applicant has clearly demonstrated that 1) the two references belong to two entirely different fields of art. Abdel-Rehim discloses a solid phase microextraction (SPME) device whereas Cronin discloses a filtering device. Aside from the fact that both devices have to do with syringes that have nothing in common which would not suggest a combination whatsoever to one skilled in the art; and (2) the suggested combination would still not lead a person of skill in the art to the claimed subject matter because it would not be capable of extracting a volatile component from a gaseous

Application Serial No. 10/581,951

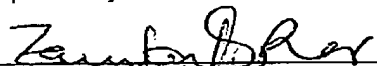
PATENT Docket: CU-4849

sample.

At least for this reason, the Office Action fails to present a *prima facie* showing of obviousness as required under MPEP 2146.01 (V)(i), and therefore, the Applicant respectfully requests withdrawal of the rejection and an indication of allowability.

Respectfully submitted,

Dated: 7-6-2010


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